

## II. REMARKS

Claims 1-5, 21, 29, 30, 37-43, 45, 48, 49, 54-58, and 60 stand rejected. Claims 23 and 46 are objected to. Claims 53 and 59 have been withdrawn from examination as a result of a requirement for restriction.

By this Supplemental Amendment, claims 1-60 are canceled without prejudice or disclaimer. Applicant respectfully reserves the right to file on more divisional or continuation applications under 35 U.S.C. § 120 to the same or similar claims. The cancellation of these claims is not intended by Applicant to be a dedication to the public of the subject matter of the cancelled claims.

Support for new claims 61 to 78 may be found in the application papers as filed, e.g., as indicated in the table below.

Support in Previous Claim	New Claim
1	61
3	62
4	70
5	71
21	77
37	63
38	64
39	65
40	66
42	67
43	68
45	69
48	72
49	73
54	74
55	75
56	76
29	78

Accordingly, an issue of new matter is not raised by the addition of these claims and entry thereof is respectfully requested.

In view of the preceding amendments and the remarks that follow, Applicant respectfully requests withdrawal of the outstanding rejections and objections to the claims.

### 35 U.S.C. § 112, First Paragraph

Claims 29, 30, 57, 58 and 60 stand rejected under 35 U.S.C. § 112, first paragraph, on the ground that the claims lack structural limitations. Without conceding the correctness of the Office's position, and merely to place the application in condition for allowance, claims 1-60 have been canceled herein without prejudice or disclaimer. New claims corresponding to objected claims 29, 30, 57, 58 and 60, have been added, each reciting a structural limitation identified in Seq. ID No. 2.

In view of the preceding amendment, reconsideration and removal of the objection under 35 U.S.C. § 112, first paragraph is respectfully requested.

Claim 45 stands objected on the ground that the specification does not support the element "conservative amino acid substitution" in the claimed mutein. During a later phone conference with the Examiner, the Examiner advised Applicant's undersigned attorney that a similar rejection would be applied to the remaining claims under examination. For this reason, the claim element "conservative amino acid substitution" has been removed from the claims. Nevertheless, for the record, Applicant respectfully disagrees and directs the Examiner's attention to page 14, line 15 to page 16, line 27, in combination with page 45, lines 20 to 25. Applicant's disclosure clearly establishes that at the time the invention was made, Applicant claimed and supported claim scope beyond proteins and polypeptides comprising Seq. ID No. 2 or fragments thereof. Applicant conceived and reduced to practice that the invention would encompass "functionally equivalent proteins and polypeptides" which includes analogs (page 14) and polypeptides that differ from the sequence shown in Seq. ID No. 2 in that the sequence contains conservative amino acid substitutions (page 45, lines 20 to 25).

In *In re Wright*, 866 F.2d 422, 9 U.S.P.Q.2d 1649 (Fed. Cir. 1989), the Federal Circuit held that the written description requirement can be met without literal support in the specification. The Examiner must take into consideration the specification as a whole, when determining whether an amended claim is new matter. In *Wright, supra*, the claim under

consideration was directed to a method for forming images. One step of the method included the deposit of a free-flowing powder. The claim was subsequently amended to add a limitation where the powder was not permanently fixed. The specification did not recite this language literally, but the original disclosure taught the absence of permanently fixing the powder. The Federal Circuit held that the exact wording in the claims is not required to be reproduced verbatim in the specification, and that the specification, *as a whole*, must be considered. The spirit and scope of the written description as indicated above as claimed, though not literally recited in the specification, nevertheless encompass "conservative amino acid substitutions".

Further, the written description requirement encompasses art-recognized equivalents of expressly disclosed aspects of the invention. As discussed in *In re Smythe*, 480 F.2d 1376, 178 U.S.P.Q.2d 279 (CCPA 1973), the court held that "[w]e cannot agree ... that in every case where the description of the invention in the specification is narrower than that in the claim there has been a failure to fulfill the description requirement in section 112." *See id.* at 1382. The court used the following hypothetical example.

If the original specification of a patent application on the scales of justice disclosed only a 1-pound "lead weight" as a counterbalance to determine the weight of a pound of flesh, we do not believe the applicant should be prevented, by the so-called "description requirement" of the first paragraph of § 112, or the prohibition against new matter of § 132, from later claiming the counterbalance as a "metal weight" or simply as a 1-pound "weight," although both "metal weight" and "weight" would indeed be progressively broader than "lead weight," including even such an undisclosed, but obviously art-recognized equivalent, "weight" as a pound of feathers.

*See id.* at 1384.

Applicants submit that the term "conservative amino acid substitutions" is an art-recognized equivalent in the field of molecular biology. In view of the foregoing, Applicant respectfully submits that the rejection is improper.

### 35 U.S.C. § 112, Second Paragraph

Claims 1-5, 21, 29, 30, 37-39, 41-43, 48, 49, 54-58 and 60 stand rejected under 35 U.S.C. § 112, second paragraph, for use of the term "FADD". Without conceding the correctness of the Examiner's position, these claims have been canceled without prejudice or disclaimer and new

claims 61 to 78 have been added. All new claims recite structure related to Sequence ID. No. 2, thereby removing the grounds for rejection.

### Informalities

Proposed claim 57 was rejected on the ground that a term lacked antecedent basis. The claim has been canceled and the informality has been removed.


### III. CONCLUSION

If a telephone interview would advance prosecution of the subject application, the Examiner is invited to telephone the undersigned at the number provided below.

In the unlikely event that the transmittal letter is separated from this document and/or the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 50-0974**, referencing attorney docket no. 128019201920. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted:

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